

REV. 11/98
For Other Than A Small Entity



Gp 2878
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✓

Docket No. LT-5 Reissue

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION FOR REISSUE OF U.S. PATENT 4,823,070

Date of Issue : April 18, 1989
Inventor : Carl T. Nelson
Title : SWITCHING VOLTAGE REGULATOR CIRCUIT
Assignee : Linear Technology Corporation
Serial No. : 08/794,374
Filing Date : December 10, 1996
Examiner : Edward Glick
Group Art Unit : 2878

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July 19, 2000

Hon. Assistant Commissioner
for Patents
Box Reissue
Washington, D.C. 20231

TRANSMITTAL LETTER

Sir:

Transmitted herewith: ☒ a Petition for Extension of Time and Response to Communication on Request for Continued Suspension of Action; to be filed in the above-identified patent application.

FEE FOR ADDITIONAL CLAIMS

☒ A fee for additional claims is not required.

☐ A fee for additional claims is required.

The additional fee has been calculated as shown below:

| | CLAIMS REMAINING AFTER AMENDMENT | HIGHEST NUMBER PREVIOUSLY PAID FOR | PRESENT EXTRA | RATE | ADDITIONAL FEES |
|---|---|---|------------------|---------|--------------------|
| TOTAL CLAIMS | - | * | = | X \$ 18 | = \$ |
| INDEPENDENT CLAIMS | - | ** | = | X \$ 78 | = \$ |
| FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM | | | | + \$260 | = \$ |

* If less than 20, insert 20. TOTAL \$

** If less than 3, insert 3.

[] A check in the amount of \$_____ in payment of the filing fee is transmitted herewith.

[X] The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 C.F.R. § 1.16, in connection with the paper(s) transmitted herewith, or credit any overpayment of same, to deposit Account No. 06-1075. A duplicate copy of this transmittal letter is transmitted herewith.

[] Please charge \$_____ to Deposit Account No. 06-1075 in payment of the filing fee. A duplicate copy of this transmittal letter is transmitted herewith.

EXTENSION FEE

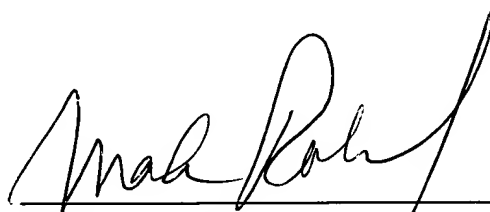
[X] The following extension is applicable to the Response filed herewith; [] \$110.00 extension fee for response within first month pursuant to 37 C.F.R. § 1.136(a); [] \$380.00 extension fee for response within second month pursuant to 37 C.F.R. § 1.136(a); [] \$870.00 extension fee for response within third month pursuant to 37 C.F.R. § 1.136(a); [X] \$1,360.00 extension fee for response within fourth month pursuant to 37 C.F.R.

§ 1.136(a); \$1,850.00 within fifth month pursuant to
37 C.F.R. § 1.36(a).

[X] A check in the amount of [] \$110.00; [] \$380.00;
[] \$870.00; [X] \$1,360.00; [] \$1,850.00 in payment
of the extension fee is transmitted herewith.

[X] The Commissioner is hereby authorized to charge
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37 C.F.R. § 1.17 in connection with the paper(s)
transmitted herewith, or to credit any overpayment
of same, to Deposit Account No. 06-1075. A
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transmitted herewith.

[] Please charge the [] \$110.00; [] \$380.00;
[] \$870.00; [] \$1,360.00; [] \$1,850.00; extension
fee to Deposit Account No. 06-1075. A duplicate
copy of this transmittal letter is transmitted
herewith.



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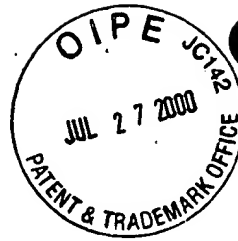
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REV. 11/98
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118

Docket No. LT-5 Reissue

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
APPLICATION FOR REISSUE OF U.S. PATENT 4,823,070

Date of Issue : April 18, 1989
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July 19, 2000

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for Patents
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PETITION FOR EXTENSION OF TIME AND
RESPONSE TO COMMUNICATION ON REQUEST
FOR CONTINUED SUSPENSION OF ACTION

Sir:

Petition Under 37 C.F.R. §1.136(a)
For Extension of Time

Pursuant to 37 C.F.R. §1.136(a), applicant hereby
petitions for a four month extension of the time period set
for response in the Examiner's Communication On Request For
Continued Suspension of Action dated February 7, 2000. A

check in the amount of one thousand three hundred sixty dollars (\$1,360.00), in payment of the fee set forth in 37 C.F.R. § 1.17(a)(4), is enclosed herewith.

Response to Examiner's Communication

This reissue proceeding is directed to U.S. Patent 4,823,070 (the "'070 Patent"). This proceeding was initiated based on reissue application Serial No. 07/683,649, filed April 10, 1991, which is the parent of the present reissue application Serial No. 08/558,204. On April 1, 1997, the present reissue application was suspended in view of concurrent litigation involving on-sale bar issues that overlap with issues in this reissue. Reissue applicant and assignee of the '070 patent, Linear Technology Corporation ("LTC"), requested that the suspension of this proceeding be continued on October 6, 1999.* In response, the Examiner held LTC's request for continued suspension in abeyance.

In its request for suspension of this proceeding, LTC stated that the invention disclosed in the '070 patent was incorporated into a five-terminal current-mode switching voltage regulator integrated circuit product sold under the designation of "LT-1070". (See ¶6 of the Reissue Declaration And Power of Attorney filed in the '649 reissue application.)

* Applicant previously submitted a status paper dated September 26, 1997, entitled Status of Concurrent Litigation and a status paper dated May 6, 1999, entitled Updated Status of Concurrent Litigation.

In addition to the invention of the '070 patent, LTC's LT-1070 product embodies subject matter claimed in U.S. Patent 4,775,741 (the "'741 patent"), entitled "Adaptive Transistor Drive Circuit." The '741 patent, like the '070 patent, is assigned to LTC, and both have a filing date of November 18, 1986.

In May 1994, LTC commenced a lawsuit against Micrel, Inc. ("Micrel") in the United States District Court for the Northern District of California, Case No. C94-1633 (now designated Linear Technology Corp. v. Micrel, Inc., C94-1633 MHP), alleging among other things that Micrel was infringing the '741 patent. In the litigation, Micrel raised the defense that claims of LTC's '741 patent are invalid in view of the on-sale bar of 35 U.S.C. §102(b).

A trial on the on-sale bar defense raised by Micrel was conducted on April 7-10, 1998.

On August 20, 1999 the District Court entered judgment on Micrel's on-sale bar defense. The Court declared that U.S. Patent 4,775,741 is invalid under 35 U.S.C. §102(b), and dismissed LTC's action against Micrel. The Court's order invalidated a patent that was not in suit (the court ruled on U.S. Patent 4,775,741, whereas the patent in suit, the '741 patent, is U.S. Patent 4,755,741). Micrel moved to amend the judgment to change the patent number, but the Court has not acted on Micrel's motion. LTC also filed a motion to amend the judgment, on which the Court has not acted. Thereafter,

LTC invoked its right to appeal the judgment to the Court of Appeals for the Federal Circuit by timely filing a notice of appeal on September 17, 1999.*

In his Communication On Request For Continued Suspension Of Action, the Examiner states that LTC's request "is deficient in that it does not identify (1) that significant overlapping issues between the ongoing appeal and the Reissue Application exist and (2) what the significant overlapping issues are and how they overlap with the prosecution of the Reissue Application."

The on-sale bar issue being addressed in the ongoing appeal presents a significant overlapping issue with the present reissue application. The invention of the '070 patent now in reissue is embodied in the same LTC LT-1070 product that was found to be on-sale more than one year prior to November 18, 1986 - the common filing dates of the '070 and the '741 patents.

The District Court's judgment, however, does not terminate the litigation because LTC has appealed the judgment as a matter of right to the Federal Circuit. LTC has appealed

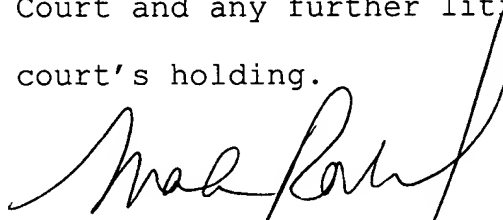
* On September 30, 1999, LTC's appeal was deactivated by the Clerk of the Federal Circuit in view of LTC's and Micrel's cross motions to amend the District Court's judgment and related findings of fact and conclusions of law. Subsequently, Micrel submitted to the Court a proposed form of order and judgment that was not opposed by LTC. The proposed form of order and judgment submitted by Micrel, when entered by the District Court, will dispose of the parties' outstanding motions and reactivate LTC's appeal.

among other things "the Findings Of Fact And Conclusions Of Law dated August 19, 1999, in which the Court held that Micrel has met its burden to prove by clear and convincing evidence that the LT1070 was on sale prior to the critical date of November 18, 1985, and found for Micrel on its section 102(b) defense, thereby invalidating the '741 patent". Tab 1. The litigation is still alive until such time when the on-sale bar issue is finally determined upon appellate review.

Accordingly, the overlapping issue is whether the reissue application should be rejected in view of the on-sale bar of 35 U.S.C. §102(b) based on the District Court's judgment. If the Federal Circuit reverses the District Court's judgment or if the District Court holds on remand that the '741 patent is not invalid under the on-sale bar of 35 U.S.C. § 102(b) then the prosecution of the present reissue application should resume. In any event, given that the on-sale bar issues is still being litigated in the courts, it would be a waste of time and resources to continue the reissue proceeding at this time. Continued suspension of the reissue proceeding avoids duplicative effort of refiling the application if the District Court's invalidity holding is overturned.

In view of the continuation of the concurrent litigation at the appellate court level, and in order to avoid duplication of effort between the litigation and this reissue proceeding, applicant respectfully requests that the hold on

LTC's request for continued suspension be vacated and that the suspension of action in this reissue application be continued until termination of the litigation, including LTC's appeal of the judgment of the District Court and any further litigation resulting from the appellate court's holding.



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07-19-2000

LILY X. JIANG


Signature of Person Signing



FILED

SEP 17 1999

RICHARD W. WIEKING
CLERK, U.S. DISTRICT COURT
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LINEAR TECHNOLOGY CORPORATION

1. Fee Paid
2. TNO Given
3. No Docket Statement

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
(SAN FRANCISCO DIVISION)**

LINEAR TECHNOLOGY CORP.,
a California Corporation,

Plaintiff,

v.

MICREL, INC.,
a California Corporation,

Defendant.

Case No. C-94-1633 MHP

**LTC'S NOTICE OF APPEAL TO THE
UNITED STATES COURT OF
APPEALS FOR THE FEDERAL
CIRCUIT**

ENTERED IN DOCKET
9/17/99

Notice is given that plaintiff Linear Technology Corporation ("LTC") hereby
appeals to the United States Court of Appeals for the Federal Circuit from:

1. the Judgment entered on August 20, 1999 invalidating United States
Patent 4,775,741 (the "741 patent") and ordering and adjudging that plaintiff take nothing,
that the action be dismissed on the merits, and that defendant Micrel, Inc. recover its costs of
action from LTC;

2. the Findings Of Fact And Conclusions Of Law dated August 19, 1999,
in which the Court held that Micrel has met its burden to prove by clear and convincing

1 evidence that the LT1070 was on sale prior to the critical date of November 18, 1985, and
2 found for Micrel on its section 102(b) defense, thereby invalidating the '741 patent;

3 3. the Order entered on March 3, 1998 to the extent that (a) it denied
4 LTC's motion in limine to preclude evidence of acts that took place outside this country or
5 that were conducted by parties outside this country, (b) granted Micrel's motion in limine to
6 exclude evidence of Micrel's subpoenas and correspondence with third parties, and (c) granted
7 Micrel's motion in limine to exclude evidence that customers were unlikely to purchase the
8 LT1070;

9 4. the Court's admission of evidence in the trial of April 7-10, 1998 as to
10 acts that took place outside this country or that were conducted by parties outside this country
11 (See, e.g., Trial Tr. pp. 326, 391-4; exhibits A-16, A-26, A-28, A-70 and A-72 through 77);
12 and

13 5. the Court's admission of exhibits A-42 and portions of A-48 and A-49
14 as evidence in the trial of April 7-10, 1998 (Trial. Tr. pp. 23, 25).

15 Respectfully submitted,

16
17 DATED: 9/17/99

18 By: 

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